

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte ANTHONY C. PARRA and DEBRA L. PARRA

Appeal 2008-2148
Application 10/075,082
Technology Center 3700

Decided: August 11, 2008

Before ERIC GRIMES, RICHARD M. LEBOVITZ, and JEFFREY N. FREDMAN, *Administrative Patent Judges*.

Opinion for the Board filed by *Administrative Patent Judge* GRIMES.

Opinion Dissenting filed by *Administrative Patent Judge* FREDMAN.

GRIMES, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a casino gaming station, which the Examiner has rejected as obvious and containing new matter. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

BACKGROUND

“The gaming area of a casino is normally divided into sections with each section offering a different game of chance to its patrons” (Spec. 1). The Specification notes that the “dealer is primarily responsible for providing table protection and game integrity, but in the absence of adequate surveillance cameras and the like, his efforts can be compromised by professional cheaters” (Spec. 1). The Specification indicates a “need for surveillance to maintain the integrity of the game being played on the table. In the past surveillance has been carried out by providing cameras in the ceiling of the establishment” (Spec. 2). The Specification comments that the “surveillance needs of a crap table, for example are different from the needs of a roulette table, and any effort to change the mix between two such types of tables will also require the reconfiguration of the cameras needed for surveillance” (Spec. 3).

DISCUSSION

1. CLAIMS

Claims 1, 2, and 4-14 are pending and on appeal. Claim 1 is representative and reads as follows:

1. A casino gaming station comprising in combination
a table having an upper surface,
said upper surface having markings thereon for use in the
playing of a game of chance,
a plurality of play stations designated on said upper surface
with each of said play stations for use by one player participating in
said game of chance,
a dealer station designated on said upper surface,
a pedestal independent of said table,
said pedestal positioned near said table,

said pedestal including a base and a unitary member attached thereto, said unitary member having a first portion extending vertically from said base,
said vertically extending first portion having an upper end,
a horizontal second portion attached to said upper end of said first portion and extending therefrom,
said horizontal second portion having an outer end,
a canopy at said outer end of said horizontal second portion,
said canopy positioned over said table,
a motion video camera positioned in said canopy to record the playing of a game on said table,
said motion video camera directed towards said upper surface of said table to provide a video of the play of said game of chance on said upper surface.

The meaning of “a unitary member . . . having a first portion extending vertically . . . [and] a horizontal second portion” is central to the issues on appeal. This limitation was added to the claims in an amendment that, Appellants argued, distinguished the claimed product from prior art that included “an upwardly extending boom 44 with a plurality of hinges along its length, such that the boom 44 is clearly not a ‘unitary member.’” (Amdt. filed Aug. 13, 2004, page 11.) The term “unitary” did not literally appear in the Specification as originally filed, but Appellants added it to the claim based on an embodiment that showed a single indivisible member with a pedestal and horizontal portion (Spec. 6; Figure 1; see *infra*). Consistently, Appellants now argue on appeal that the claim language requires “that the ‘horizontal second portion’ extends from the upper end of the ‘vertically extending first portion’ where the first and second portions make[] up a single ‘unitary member.’” (Appeal Br. 8.)

During examination proceedings, claim terms are given “the broadest reasonable meaning . . . in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification.” *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). The meaning given to claim terms must be consistent with how they would be read by those of ordinary skill in the art. See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-13 (Fed. Cir. 2005)(“[T]he words of a claim ‘are generally given their ordinary and customary meaning.’ . . . [T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention.”).

We interpret the claim limitation reciting a “unitary member” having vertical and horizontal portions to mean a single, undivided element having a portion that is generally vertical and a portion that is generally horizontal, and to exclude an element that is made up of separate parts joined together. This interpretation is consistent with the disclosed embodiment shown in the application's Figure 1 which served as written descriptive support for the term “unitary” (further discussed *infra*), with the position taken by Appellants during prosecution, and also with the plain meaning of “unitary.” In reaching this interpretation, we are not improperly limiting the claims to embodiments found in the Specification as asserted by the dissent, but instead we are interpreting the claim language in the light of the Specification and the particular circumstances which caused the claim to be amended by the insertion of “unitary.”

It is true, as our dissenting colleague notes, that some dictionary definitions of “unitary” could be stretched to include an element made up of multiple units. Different definitions apply in different contexts, however.

The Oxford English Dictionary¹ provides a comprehensive definition of “unitary” that also suggests which definition applies in different contexts. The definitions include the following: “Of or pertaining to, characterized by, based upon, or directed towards, unity” and “Of the nature of a unit; having the separate existence or individual character of a unit.” No particular context or field of use is indicated for those definitions.

The definitions of “unitary” also include: “Of or pertaining to a unit or units,” which is similar to the definition relied on by the dissent. That definition, however, is said to be applicable “esp. in *Chem.* [chemistry] and *spec.* [specifically] as denominating a theory or system in which the molecules of all bodies are regarded as units.”

Thus, the evidence of record indicates that those of ordinary skill in the art of designing surveillance devices would have understood, in the context of the Specification, the ordinary and customary meaning of “unitary” to mean an element that is a single unit, not an element made of multiple units attached to each other.

2. NEW MATTER

Claims 1 and 10 stand rejected under 35 U.S.C. § 112, first paragraph, on the basis that “[n]owhere in the specification is there a provision for a unitary member having a first portion and/or a second portion attached

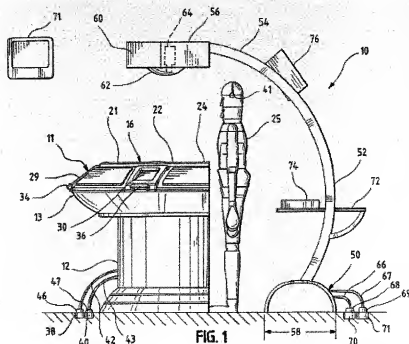
¹ Oxford English Dictionary Online (<http://dictionary.oed.com>), entry for “unitary,” accessed Aug. 1, 2008.

thereto. Indeed, the use of a first portion and a second portion teach away from a unitary member.” (Answer 13.)

Appellants argue that “the examiner has totally disregarded the drawing of the device as depicted in Fig. 1 . . . and has cited his portions of the text out of context. . . . Fig. 1 clearly depicts the combined elements of the post 52 and extension 54 as a unitary member even though the word ‘unitary’ is not used in the Specification.” (Reply Br. 9.)

The Examiner bears the “initial burden [to] present [] evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.” *In re Wertheim*, 541 F.2d 257, 263 (CCPA 1976). The words used in the claims need not appear verbatim in the Specification in order to satisfy the written description requirement; what is needed is a description that shows possession of what is later claimed to a person of ordinary skill in the art. *Purdue Pharma L.P. v. Faulding, Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000). “[U]nder proper circumstances, drawings alone may provide a ‘written description’ of an invention as required by § 112.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1565 (Fed. Cir. 1991).

The Specification's Figure 1 is reproduced below:



The figure shows “a side elevational view of a gaming table, pedestal and canopy in accordance with the present invention” (Spec. 4), including “a pedestal 50 supporting an upwardly extending vertical post 52, the upper end of which supports a horizontally outwardly extending portion 54 at the end of which is a canopy 56” (*id.* at 6).

We agree with Appellants that the Specification provides adequate descriptive support for the “unitary member” recited in claims 1 and 10. While the word “unitary” does not appear in the Specification, the Specification’s Figure 1 shows an embodiment of the invention that contains a pedestal with a unitary member described as having a vertical portion and a horizontal portion. Given the embodiment of Figure 1, we find that the written description of the invention, as originally filed, conveys to those of

skill in the art that the inventor was in possession of the claimed invention at the time the application was filed.

We reverse the rejection of claims 1 and 10 under 35 U.S.C. § 112, first paragraph.

3. OBVIOUSNESS

Claims 1 and 10 stand rejected under 35 U.S.C. § 103 as obvious in view of Walsh² and Wilton.³ The Examiner relies on Walsh for its disclosure of a table, canopy, and camera meeting the limitations of claims 1 and 10 (Answer 3-4). The Examiner finds that Wilton discloses a structure meeting the limitations of the pedestal recited in the claims:

Wilton et al. teaches a pedestal that includes a base member (5) and a unitary member extending vertically from the base until an upper end, the part above (5), see figure 1. At the upper [e]nd, a horizontal member (4), the second portion, extends until an upper end wherein a "canopy" (2) containing the camera (3) is disposed.

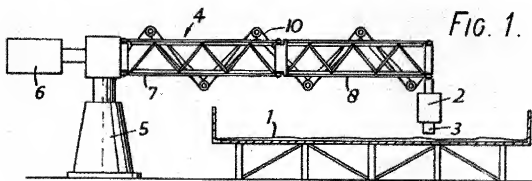
(Answer 4.) The Examiner concludes that "[i]t would have been obvious to one of ordinary skill in the art to employ the structural means of Wilton et al. into the system of Walsh et al." (*id.* at 5). The Examiner also concludes that "[f]urther, it would be obvious to a skilled artisan that when employing the structure into the system of Walsh that a casino would not require the movement and hinging that a movie studio would and that the crane could become integral and still serve the functions required by the casino" (*id.* at 4).

² Walsh, U.S. Patent 5,726,706, issued Mar. 10, 1998.

³ Wilton et al., U.S. Patent 3,643,345, issued Feb. 22, 1972.

Appellants argue that the arm of the Wilton device is not unitary and it would not have been obvious to make Wilton's arm as a unitary member (Appeal Br. 8).

Wilton discloses a "terrain model viewing device for an aircraft flight simulator compris[ing] an articulated arm mounting a camera at its free end and having its other end pivotally mounted on a base" (Wilton, abstract). Wilton's Figure 1, which the Examiner cites, is reproduced below:



The figure shows "a side elevational view of a camera support structure" (*id.* at 2: 4-5). The structure includes "articulated arm 4 which can swing about a vertical axis on a support pedestal 5" (*id.* at 2: 25-26). "The articulated arm 4 is counterbalanced by a counterweight 6 and consists of an inner arm 7 and an outer arm 8" (*id.* at 2: 27-28).

Thus, Wilton's camera support structure is made up of separate vertical and horizontal elements, and the horizontal element itself is made up of separate structures. We agree with Appellants that Wilton does not disclose a unitary member that includes vertical and horizontal portions, as required by claims 1 and 10.

Nor has the Examiner adequately shown that the cited references would have suggested the claimed product to a person of ordinary skill in the

art. The purpose of the Wilton's camera support structure is to allow movement of a camera across a terrain model (Wilton 1: 53-58). We agree with Appellants that modifying Wilton's camera support structure by making it a unitary member would make the device inoperable for Wilton's purpose (Appeal Br. 9).

The Examiner has pointed to nothing in Walsh as a basis for concluding that a unitary member having vertical and horizontal portions would have been obvious. Thus, the Examiner has not shown that the cited references themselves would have suggested this limitation of the claims.

The Examiner has asserted that a person of ordinary skill in the art would have recognized that Wilton's camera support structure would not have required hinging and movement if used in a casino surveillance system and therefore "the crane could become integral [sic, unitary?] and still serve the functions required by the casino" (Answer 4).

In our view, this rationale is not adequate to show that the prior art would have made the product of claims 1 and 10 obvious to those of ordinary skill in the art. Although the U.S. Supreme Court recently held that the "teaching-suggestion-motivation" (TSM) test cannot be applied in a rigid and mandatory way, it did not discard the test completely. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). The Court held that the TSM test must be applied flexibly, but stated that "it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements in the way the claimed new invention does." *Id.* "To facilitate review, this analysis should be made explicit." *Id.*

The U.S. Court of Appeals for the Federal Circuit, as well, has cautioned that “[w]e must still be careful not to allow hindsight reconstruction of references to reach the claimed invention without any explanation as to how or why the references would be combined to produce the claimed invention.” *Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1374 n.3 (Fed. Cir. 2008).

In our view, the Examiner’s reasoning relies on the type of hindsight reconstruction that the courts have long warned against. The Examiner’s reasoning, in essence, is that a person of ordinary skill in the art would have considered it obvious to incorporate Wilton’s camera support structure into Walsh’s casino surveillance product. Then, after combining the two products, the skilled artisan would have recognized that a camera support structure that can move – the whole point of Wilton’s device – would be unnecessary in the context of Walsh’s product and therefore would have modified Wilton’s device to eliminate the very features that Wilton describes as making it functional. The Examiner has pointed to nothing in the cited references or the knowledge of those skilled in the art as suggesting the desirability of making the proposed modifications to the prior art products.

We conclude that the Examiner has not adequately explained what would have led a person of ordinary skill in the art to modify the prior art products in the way defined by claims 1 and 10. Because the Examiner has not made out a prima facie case of obviousness, we reverse the rejection of claims 1 and 10 under 35 U.S.C. § 103.

Claims 2, 4-9, and 11-14 also stand rejected under 35 U.S.C. § 103, as follows:

- Claim 2 as obvious in view of Walsh, Wilton, and Wynn⁴ (Answer 6);
- Claims 4, 7, and 12 as obvious in view of Walsh, Wilton, and Sines⁵ (Answer 7);
- Claim 5 as obvious in view of Walsh, Wilton, and Parra⁶ (Answer 9);
- Claims 6 and 11 as obvious in view of Walsh, Wilton, and Jones II⁷ (Answer 10); and
- Claims 8, 9, 13, and 14 as obvious in view of Walsh, Wilton, and Breeding⁸ (Answer 11).

Each of these rejections depends on the combination of Walsh and Wilton, and cites an additional reference to meet the limitations of dependent claims. The Examiner has not, however, pointed to any disclosure in any of the additional references that makes up for the failure of Walsh and Wilton to teach or suggest a unitary member comprising vertical and horizontal portions. Therefore, all of the obviousness rejections suffer from the same infirmity discussed above, and are reversed for the same reason.

REVERSED

⁴ Wynn et al., U.S. Patent 5,971,271, issued Oct. 26, 1999.

⁵ Sines et al., U.S. Patent 6,270,404 B2, issued Aug. 7, 2001.

⁶ Parra et al., U.S. Patent 5,839,960, issued Nov. 24, 1998.

⁷ Jones II et al., U.S. Patent 6,154,131, issued Nov. 28, 2000.

⁸ Breeding et al., U.S. Patent 6,299,534 B1, issued Oct. 9, 2001.

FREDMAN, *Administrative Patent Judge*, dissenting.

I respectfully dissent from the Majority's interpretation of the term "unitary" and therefore would affirm the Examiner's rejection under 35 U.S.C. § 103(a).

Claim Interpretation – Caselaw

In my opinion, the Majority misinterpreted the breadth of the term "unitary" based upon an unduly narrow reading of a term which never appeared in Appellants Specification, rather than interpreting the claim in the manner prescribed by the Federal Circuit. In *Trans Texas Holdings*, the Federal Circuit provided a clear description of how to construe claims, noting

In *Phillips*, we held that while "the specification [should be used] to interpret the meaning of a claim," courts must not "import[] limitations from the specification into the claim." *Id.* at 1323. We specifically noted that it is improper to "confine the claims to th[e] embodiments" found in the specification, as *Trans Texas* asks us to do. *Id.*

In re Trans Texas Holdings Corp., 498 F.3d 1290, 1299 (Fed. Cir. 2007).

In *Trans Texas Holdings*, the term at issue was "responsive to the rate of inflation" and the term was defined as "directly responsive to a market indicator." See *Id.* at 1298. The Court noted that "Trans Texas argues that immediate responsiveness is the only construction consistent with the specification because 'each of the examples in the '461 specification ... [is] adjusted on a one-for-one basis.'" *Id.* at 1298-1299. The dispute was whether the phrase "directly responsive" required immediate responsiveness

as argued by Trans Texas or whether the term “directly” could be construed more broadly as argued by the BPAI. *See Id.* at 1298.

The Federal Circuit first pointed out that “courts must not ‘import[] limitations from the specification into the claim.’ . . . We specifically noted that it is improper to ‘confin[e] the claims to th[e] embodiments’ found in the specification, as Trans Texas asks us to do.” *Id.* at 1299.

The Federal Circuit noted that “[u]nder *Phillips*, dictionary definitions are also pertinent. *See id.* at 1318 (‘[T]he court has observed that dictionaries . . . can be useful in claim construction.’).” *Id.* at 1299. The Federal Circuit expressly commented that there were multiple dictionary definitions for the term “directly” but chose the “broadest” definition. *See Trans Texas Holdings*, 489 F.3d at 1299. (“While some definitions define ‘directly’ as ‘simultaneously and exactly or equally’ or ‘immediately,’ other definitions define it as ‘after a little: in a little while: shortly, presently.’ *Webster’s Third New International Dictionary Unabridged* 641 (2002). In view of the latter definitions, we conclude that the broadest reasonable interpretation of ‘directly responsive’ is not limited to situations in which the inflation-adjustment occurs immediately after any increase in the reported rate of inflation, but also includes situations in which the inflation-adjustment occurs ‘a little while’ after an increase in the reported rate.”)

Thus, the Federal Circuit affirmed a Board decision in which the Board selected a dictionary definition that was broader than the examples disclosed in the Specification and was the broader dictionary definition. *See Trans Texas Holdings*, 489 F.3d at 1298-1299.

Claim Interpretation – “unitary”

Applying the guidelines of *Trans Texas* to the instant facts, I conclude that the Majority is importing limitations from the Specification into the claim, specifically importing the “single, undivided element having a portion that is generally vertical and a portion that is generally horizontal” disclosed in Appellants figure as limiting the definition of the term “unitary”.

However, this approach is not consistent with the caselaw, “although the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments. . . In particular, we have expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005).

The Majority cites the Oxford English Dictionary definition of “unitary” and argues that the “Of or pertaining to a unit or units,” definition upon which I rely is related to chemistry. Other dictionaries disagree. Specifically, the Random House Dictionary⁹ defines “unitary” as “1. of or pertaining to a unit or units. 2. of, pertaining to, characterized by, or aiming toward unity”. The American Heritage Dictionary¹⁰ defines “unitary” as “1. of or pertaining to a unit. 2. Having the nature of a unit; whole. 3. Based on or characterized by one or more units.”

⁹ Random House Dictionary of the English Language, Second Edition, unabridged 2074 (1993).

¹⁰ The American Heritage Dictionary of the English Language 1400 (1975).

Webster's Third New International Dictionary¹¹ particularly disagrees with the Majority's narrow reading of "unitary" as composed of units as limited to chemistry, noting in one definition of "unitary" as "made up of discrete units (a loudspeaker with four speaker units associated in a single assembly)." Just as a loudspeaker may be composed of multiple speaker units, as will be further discussed below, the articulated arm in Wilton is composed of multiple units (Wilton, col. 2, ll. 24-25).

In a situation where the word "unitary" does not appear in the Specification and the Specification provides no definition for the word "unitary", I would not import a limiting understanding of the term from a figure of the Specification, but would rather interpret the word "unitary" broadly, consistent with definitions which are found in every dictionary that a "unitary" element may be composed of multiple units and consistent with mode of claim interpretation promulgated by the Federal Circuit in *Phillips*, *Trans Texas*, and innumerable other cases.

I would approach the rejections as presented by the Examiner as follows.:

A. 35 U.S.C. § 103(a) rejection over *Walsh and Wilton*

The Appellants "strongly denies that the arm of the Wilton device is unitary, or that it is obvious to make the arm of Wilton as a rigid unitary member including a vertical and horizontal portion as the examiner asserts" (App. Br. 8). Appellants further contend that

to modify the Wilton crane as the examiner would have done, would render the device of Wilton inoperable for the purpose for which it is intended. Specifically, if the device of Wilton includes a vertical post

¹¹ Webster's Third New International Dictionary of the English Language Unabridged 2500 (1971).

and extending arm made as a unitary member, it could not be used to simulate the view of the ground below as seen from an aircraft moving across the surface of the earth.

(App. Br. 9.)

Appellants also argue the Parra declaration supports nonobviousness, noting that “cameras have been used to monitor the play on casino tables since circa 1970, but that in all the time since then, a camera mounted on a freestanding structure as claimed has not been used to photograph the play on a casino table” (App. Br. 9).

The Examiner “maintains that the combination of the references the rejection above teach a pedestal with a[n] arm that can be set in a fixed position over a table to mount equipment such as cameras” (Ans. 13). The Examiner further argues that “it would be obvious to a skilled artisan that when employing the structure into the system of Walsh that a casino would not require the movement and hinging that a movie studio would and that the crane could become integral and still serve the functions required by the casino” (Ans. 14).

In view of these conflicting positions, I frame the obviousness issue as follows:

Would it have been obvious to a person of ordinary skill to modify the casino gaming station of Walsh with the gantry of Wilton in order to place the security camera on a unitary member?

Findings of Fact (FF)

1. Walsh teaches “exposed cameras positioned at some distance from the gaming tables or gaming area . . . there is a continuing need for

improved security systems in gaming establishments” (Walsh, col. 1, ll. 30-34).

2. Walsh discloses a table with an upper surface including “a crap table or roulette table” which is reasonably interpreted to comprise a plurality of play stations and a dealer station (Walsh, fig. 1, 7; Walsh, col. 4, ll. 58-59).

3. Walsh teaches “a lighting surveillance fixture **22** suspended . . . over a gaming apparatus **25**. . . The lighting surveillance fixture **22** includes a plurality of lamp assemblies **30** and one or more surveillance pods **31**” (Walsh, col. 2, ll. 37-45).

4. Walsh teaches that “[c]oncealed cameras **203** are mounted at each end at a selected angle such that the pair of cameras together sweeps, i.e. provides the video imaging of, the entire surface **327** of the table **325**” (Walsh, col. 4, ll. 61-64).

5. Wilton teaches a “camera for viewing the terrain model, a fixed support base and an articulated arm pivotally mounted on the base and supporting the camera” (Wilton, col. 1, ll. 46-48).

6. Wilton teaches that the “pedestal support 5 carries an appropriate motor system for rotating the inner arm portion” (Wilton, col. 2, ll. 31-32).

7. Wilton teaches that the “camera 2 is mounted for rotation about a vertical axis on the end of an articulated arm 4” (Wilton, col. 2, ll. 24-25).

8. The ordinary and customary meaning of “unitary” is “adj. 1 of a unit or units”¹².

9. Wilton teaches that “the articulated arm is in two sections and the axis of articulation between the two sections is vertical, the arm being mounted for pivotal movement on the base about a vertical axis” (Wilton, col. 1, ll. 49-52).

10. Wilton discloses that the articulated arm 4 is composed of a number of struts which represent the units that compose the articulated arm 4 (*see* Wilton, figs. 1 and 2).

11. Wilton discloses an arm which rises vertically from base 5 (*see* Wilton, figs. 1 and 3).

Discussion of 35 U.S.C. § 103(a) over Walsh and Wilton

Claim 1

Walsh teaches a casino gaming station with a gaming table that has a plurality of play stations and a dealer station which is subject to video surveillance (FF 1-2). Walsh further discloses a canopy above the table which incorporates a video camera that is positioned to record the table (FF 3-4). Wilton teaches a camera, mounted on an articulated arm, that may be positioned over a table and which can be moved using a motor in the pedestal (FF 5-7).

Appellants dispute centers around whether the articulated arm in Wilton satisfies the “unitary member” requirement of claim 1. Therefore, in analyzing claim 1, I begin by interpreting the meaning of the limitation “unitary member” (Claim 1). Not only does the Specification not provide a

¹² Webster’s New World Dictionary 1459 (Rev. Ed. 1988).

specific definition of the term “unitary member”, the Specification as filed never used the word “unitary”. The word was added in an amendment in the August 13, 2004 response which relied upon the disclosure of Figure 1 of the Specification for descriptive support for “unitary”.

The word “unitary” is defined as “of a unit or units” (FF 8). As discussed extensively above, I would therefore interpret the “unitary member” in claim 1 as encompassing members composed of a single unit or composed of multiple units. *See, e.g., In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000) (“[D]uring examination proceedings, claims are given their broadest reasonable interpretation consistent with the [S]pecification.”).

Applying this definition of “unitary” to the articulated arm of Wilton, I would find that the articulated arm is composed of units.

I conclude that the Examiner has set forth a *prima facie* case that claim 1 would have been obvious to the ordinary artisan in view of Walsh and Wilton. In *KSR*, the Supreme Court indicated that “[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1740 (2007). In the instant case, using the viewing device of Wilton with the gaming table of Walsh would have been a known and predictable way to more effectively allow positioning of a video camera for security at a gaming table (*see* FF 1, 4, 6, 7).

I am not persuaded by Appellants’ argument which “denies that the arm of the Wilton device is unitary” (App. Br. 8). As discussed extensively

above, the word “unitary” is defined as composed “of a unit or units” (FF 8). Appellants’ discussion of the multiple units which compose the articulated arm of Wilton and the multiple segments that are hingedly connected to one another (App. Br. 8) supports the conclusion that the arm of Wilton is “unitary”. I would find that the arm of Wilton is composed of units (FF 9-10) whether these units are represented by the two components of the arm taught by Wilton (FF 9) or the multiple struts which form the arm (FF 10). I would further find that the arm of Wilton extends both vertically and horizontally from the base (FF 11, Wilton, fig. 1). I do not find persuasive Appellants’ statement that the addition of “unitary” was added “for the sole purpose of distinguishing the articulating arm of the previously cited Chapman reference” (App. Br. 8). As I have broadly interpreted the term “unitary” based upon its ordinary dictionary meaning, I would conclude that the Wilton arm satisfies this limitation.

Appellants also argue that modifying the “Wilton crane as the examiner would have done, would render the device of Wilton inoperable for the purpose for which it is intended” (App. Br. 9). This argument relies upon a narrow interpretation of “unitary” which I do not find persuasive. In my opinion, the issue is not whether the Wilton arm would be operable to simulate terrain at the casino table, but whether it would have been obvious to an ordinary practitioner to combine the concepts disclosed in Walsh and in the Wilton arm and camera device to use such a device in monitoring casino gaming tables. I would conclude that such a combination is merely a “predictable use of prior art elements according to their established functions.” *KSR*, 127 S. Ct. at 1740.

I have considered the Parra Declaration, but find that the Declaration simply states a conclusion that “mounting of a camera on a pedestal having a fixed upwardly extending member and a fixed arm that extends over a gaming table as claimed in my above mentioned patent application has not been used in a casino prior to my invention” (Parra Declaration). However, the issue is not whether there is anticipatory prior art, but whether the invention is obvious over the teachings of Walsh and Wilton.

As for the assertion of long-felt need in the art and the solution thereto by the claimed invention (*see* App. Br. 9), the relevant consideration is a long-felt but unsolved need in the art. *Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH*, 139 F.3d 877 (Fed. Cir. 1998). In short, the Parra declaration does not provide any evidence corroborating the asserted existence of a long-felt need in the art or the failure of others to solve the problem (*see Vandenberg v. Dairy Equip. Co.*, 740 F.2d 1560, 1567 (Fed. Cir. 1984))

Claim 10

Appellants argue that the “‘unitary member’ as described in claim 10 is “a little different than as described in claim 1. In claim 10, the ‘horizontal second portion’ is specifically defined as being part of the ‘unitary member’” (App. Br. 10). I find that Wilton teaches a horizontal member (such as support 14 disclosed in fig. 3 of Wilton) which is the camera assembly which holds the camera that is rotated around the articulated arm (FF 7). I would conclude that the combination of Walsh and Wilton to teach the use of such an assembly is merely a “predictable use of prior art

elements according to their established functions.” *KSR*, 1727 S. Ct. at 1740.

I would affirm the rejection of claims 1 and 10 under 35 U.S.C. § 103(a) as obvious over Walsh and Wilton.

B. 35 U.S.C. § 103(a) rejection over Walsh, Wilton, and Wynn

Appellants argue “Wynn provides for a ‘handset’ rather than a ‘headset’ as required by claim 2. The device of Wynn is no more than a telephone to be used by a player to contact casino personnel. Wynn does not disclose a device for providing oral communication between a dealer and a remote supervisor as required by claim 2” (App. Br. 11).

The Examiner responds that

Wynn et al. disclose incorporating an audio channel between a user and a central location manned by those who can communicate with the user in order to provide assistance (Abstract). Though Wynn et al. disclose this functionality to assist the players, one of ordinary skill in the art would immediately recognize the functionality disclosed by the handset device could be equally adaptive to a table game in order to keep the dealer in communication with supervisors.

(Ans. 16.)

In view of these conflicting positions, I frame the obviousness issue as follows:

Would it have been obvious to a person of ordinary skill to modify the casino gaming station of Walsh and Wilson in view of Wynn to incorporate a headset for communication?

Findings of Fact

12. Wynn teaches that “[w]e have added to the player’s gaming device a number of features They include a telephone handset or call button” (Wynn, col. 2, ll. 23-26).

13. Wynn teaches that a conceirge may have an “operator type headset represented here, simply as a telephone handset **44**” (Wynn, col. 5, ll. 34-35).

Discussion of 35 U.S.C. § 103(a) over Walsh, Wilton, and Wynn

In my opinion, the “for use by the dealer connected to a supervisor at a remote location” language in claim 2 represents a functional recitation and functional language. It is “well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable.”

In re Schreiber, 128 F.3d 1473, 1477 (Fed. Cir. 1997). Thus, functional limitations directed to the intended use of a product claim do not serve to distinguish the claimed product from prior art products inherently capable of performing the claimed function. *See id.* at 1478-79 (holding that a prior art apparatus meeting all claimed structural limitations was anticipatory because it was inherently capable of performing the claimed function).

Consequently, I would find that Wynn teaches the use of a handset with a casino gaming station (FF 12) and the equivalency of a handset and a headset (FF 13). In *KSR*, the Supreme Court indicated that “[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727,

1740 (2007). In the instant case, the use of a headset at the casino gaming station of Walsh and Wilton is a predictable variation based upon the teachings of Wynn (FF 12-13).

I would affirm the rejection of claim 2 under 35 U.S.C. § 103(a) as obvious over Walsh, Wilton, and Wynn.

C. 35 U.S.C. § 103(a) rejection over Walsh, Wilton, and Sines

Appellants argue that the “system and apparatus disclosed by Sines clearly cannot serve the function for which it is intended and simultaneously display the view of the gaming table as seen from the overhead camera as would be required by claims 7 and 12” (App. Br. 12).

The Examiner responds “Sines et al. discloses using a monitor for displaying the game to the user as the user plays (FIG 2). These monitors show the contents of the game to the players by substituting for actual cards. Further, during idle times in the game, the monitors are used to display advertising material to the players” (Ans. 17).

In view of these conflicting positions, I frame the obviousness issue as follows:

Would it have been obvious to a person of ordinary skill to modify the casino gaming station of Walsh and Wilson in view of Sines to incorporate video monitors to watch gameplay?

Findings of Fact

14. Sines teaches that at the player station “there can be some attract mode advertising of the casino or game” (Sines, col. 17, ll. 33-34).

15. Sines teaches that the “player displays 103 are also advantageously presented in an upwardly facing orientation and contained in

a single plane or approximately a single plane, to facilitate easy viewing by other players from around the table” (Sines, col. 10, ll. 51-54).

Discussion of 35 U.S.C. § 103(a) over Walsh, Wilton, and Sines

I find that placement of a video display on the pedestal, rather than the game table as disclosed by Sines, represents an obvious equivalent way in which to “facilitate easy viewing by other players from around the table” (FF 14-15). I agree with the Examiner that the ordinary artisan would have been motivated to place the monitor on the pedestal apparatus “because when the monitor would be displaying advertising material as disclosed by Sines et al. it: would reach a greater amount of people in the casino as opposed to just the players of the table game thus enhancing the value of the advertisement” (Ans. 8). I would conclude that the combination of Sines with Walsh and Wilton is merely a “predictable use of prior art elements according to their established functions.” *KSR*, 1727 S. Ct. at 1740.

I am not persuaded by Appellants argument that “displays of Sines, however, cannot be used to project a view of the game as seen from the camera in the canopy overhead while the game is in fact in play because the videos of the Sines device are a fundamental element of the game itself” (App. Br. 12). This is clearly incorrect, since a person of ordinary skill would easily be capable of facilitating easy viewing of the game by connecting the pedestal camera to a monitor located on the pedestal, rather than embedded in the game table. Wilton teaches cables which go through the entire pedestal device (*see* Wilton, col. 2, ll. 37-40; figs. 1-3).

I would affirm the rejection of claims 7 and 12 under 35 U.S.C. § 103(a) as obvious over Walsh, Wilton and Sines.

D. 35 U.S.C. § 103(a) rejection over Walsh, Wilton, and Parra

The Examiner concludes that claim 5 is obvious over Walsh, Wilton, and Parra (Ans. 9-10). Appellants argue that claim 5 stands or falls with claim 1 (App. Br. 12). I would also affirm the rejection of claim 5 as this claim was not argued separately.

E. 35 U.S.C. § 103(a) rejection over Walsh, Wilton, and Jones II

The Examiner concludes that claims 6 and 11 are obvious over Walsh, Wilton, and Jones II (Ans. 10). Appellants argue that claims 6 and 11 stand or fall with claim 1 (App. Br. 12). I would also affirm the rejection of claims 6 and 11 as these claim were not argued separately.

F. 35 U.S.C. § 103(a) rejection over Walsh, Wilton, and Breeding

The Examiner concludes that claims 8, 9, 13, and 14 are obvious over Walsh, Wilton, and Breeding (Ans. 11-12). Appellants argue that claims 8, 9, 13, and 14 are patentable because “Breeding, however, does not disclose a separate free standing pedestal, but rather an extension 34 to the table itself” (App. Br. 13). I find that placement of the extension on the pedestal, rather than the game table as disclosed by Breeding, represents an obvious equivalent way in which to permit easy access of the cards or chips for the dealer. I would conclude that the combination of Breeding with Walsh and Wilton is merely a “predictable use of prior art elements according to their established functions.” *KSR*, 1727 S. Ct. at 1740.

G. 35 U.S.C. § 112, first paragraph rejection

I concur with the majority regarding the written description rejection regarding new matter.

Appeal 2008-2148
Application 10/075,082

Ssc:

ROBERT L. MARSH
54 DANADA DRIVE
P.O. BOX 4468
WHEATON, IL 60187-4468